

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John J. Sie et al.

Application No.: 09/687,151

Filed: October 12, 2000

For: PRE-STORING A PORTION OF A
PROGRAM TO ALLOW USER
CONTROL OF PLAYBACK

Customer No.: 20350

Confirmation No. 8606

Examiner: Brown, Rueben M.

Technology Center/Art Unit: 2424

PRE-APPEAL BRIEF REQUEST FOR
REVIEW

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Appellants respectfully request review of the final rejections mailed by the Office for the above-referenced application on January 27, 2010 ("the Final Office Action"). An Advisory Action was mailed on June 1, 2010 indicating that the Response Filed on April 27, 2010 under 37 C.F.R. 1.116 ("the Response to the Final Office Action") did not place the application in condition for allowance. A Notice of Appeal is being filed concurrently herewith. This Request for Review is pursued for the reasons given below.

STATUS OF CLAIMS

Claims 1-4, 6-13, 21, 22, 25, and 27-34 are pending in the application. Claims 1-4, 6-13, 21, 22, 25, and 27-34 were rejected in the Office Action under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,990,676 to Pochl et al.

(hereinafter "Prochl") in view of the cited portions of US Patent No. 5,884,141 to Inoue (hereinafter "Inouc"), further in view of US Patent No. 6,986,156 to Rodriguez (hereinafter "Rodriguez"). The after-final amendment was not entered. The below argument is made presuming the amendment was not entered.

REVIEW REQUESTED FOR THE FOLLOWING REASONS

Appellants believe that claims 1-4, 6-13, 21, 22, 25, and 27-34 are allowable over the cited references at least for the reason provided in the Appellants' Response dated April 27, 2010. Specifically, the rejection of the independent claims is based, in part, on Rodriguez et al., which is not prior art. Prior art references are irrelevant to patentability of the present invention.

REMARKS/ARGUMENTS

Rodriguez et al. Not Prior Art

Each of the independent claims 1, 9, 30 and 31 generally recites receiving first and second portions of a program on a plurality of channels with different media types chosen from a group of types consisting of a multicast media or a singlecast media, further wherein the singlecast media is a dedicated digital channel. This limitation was first described in provisional patent application no. 60/163,324, (hereinafter, '324 provisional) filed on November 3, 1999, upon which this application claims benefit. The '324 provisional teaches this limitation at least at page 7, ll. 20-21. The Office Action relies on U.S. Patent No. 6,986,156 to Rodriguez (hereinafter, Rodriguez '156) for teaching this limitation. Rodriguez '156 was filed on June 9, 2000 and claims the benefit of two provisional applications, 60/170,302 filed December 13, 1999, and 60/138,756 filed June 11, 1999 (hereinafter '756). Alone, Rodriguez '156 is not on its face prior art and Applicants are entitled to a new office action.

The Office may point out that Rodriguez '756 could be prior art if it taught the limitation in question. In order the teachings of Rodriguez to be prior art, the Rodriguez '756 provisional filed on June 11, 1999 would have to teach the limitations relied upon in the rejection. The cited portion of Rodriguez '156 describes "a bandwidth allocation scheme that employs auxiliary channels to support full random access functionality during a parallel near-video-on-demand (NVOD) service." See Col. 21, ll. 24-27. However, the Rodriguez '756

provisional does not teach using a VOD service in parallel with a NVOD service, it only discusses VOD service. Therefore, it is believed that even though Rodriguez '756 could be considered prior art from a timing perspective, Applicants do not believe that Rodriguez '756 teaches these limitations. If any future actions rely on the Rodriguez '156 patent to reject any claims, applicant respectfully requests that the future action should cite where the limitations are taught in Rodriguez '756.

35 U.S.C. §103 Rejections

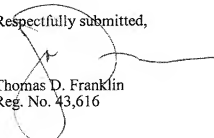
The Final Office Action ("Office Action") has rejected claims 1-4, 6-13, 21-22, 25 and 27-34 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,990,676 to Proehl et al. (hereinafter "Proehl") in view of the cited portions of U.S. Patent No. 5,884,141 to Inoue (hereinafter "Inoue"), further in view of U.S. Patent No. 6,986,156 to Rodriguez (hereinafter "Rodriguez"). As discussed above, Rodriguez is not prior art to this application. Therefore, it is respectfully requested that the finality of the Office Action be withdrawn and either the claims be allowed, or a new non-final office action be issued.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Thomas D. Franklin
Reg. No. 43,616

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
Attachments
TDF:s6c

62740282 v1